

REMARKS**SUMMARY:**

The present application sets forth original and amended claims 1-3, 5-8, 10-13, 15-18, and 20-29, of which claims 1, 6, 11, and 16 are independent claims.

Original and previously amended claims 1-3, 5-8, 10-13, 15-18, and 20-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,269,373 to Apte et al. (Apte) in view of U. S. Patent No. 6,237,135 to Timbol and further in view of U. S. Patent No. 6,836,889 to Chan et al. (Chan).

Responses to the rejection summarized above are hereafter provided with respect to each individual argument presented by the Examiner.

REJECTION OF CLAIMS 1-3, 5-8, 10-13, 15-18, and 20-29 (35 U.S.C. §103(a)):

Original and previously amended claims 1-3, 5-8, 10-13, 15-18, and 20-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,269,373 to Apte et al. (Apte) in view of U. S. Patent No. 6,237,135 to Timbol and further in view of U. S. Patent No. 6,836,889 to Chan et al. (Chan). Based on the following remarks, Applicants respectfully traverse such alleged anticipation.

Before setting forth a discussion of the prior art applied in the recent Office Action, it is believed that a general discussion of the disclosed subject matter may be helpful as background to a discussion of the specifically claimed subject matter.

In general, the present technology is directed towards a CORBA jellybean method and system wherein the jellybeans are automatically generated. More particularly, as discussed starting with the Summary of the Invention on page 2 of the specification, the present subject matter discloses a system and method for providing

interaction between a client and a server. As may also be noticed from the present specification at page 4, CORBA jellybeans, which replace the adapter layer in typical previous client server architectures, correspond to a library of invisible beans that provide reusable classes to an application program or to help solve problems in the area of internationalization, undue formatting, and similar areas. As further described in the present specification at pages 11-12 and as illustrated in application Figs. 4 and 5, CORBA jellybeans in accordance with the present disclosure are **automatically** generated.

With such brief background in mind, and before setting forth a discussion of the referenced prior art patents, it is respectfully submitted that controlling case law has frequently addressed rejections under Section 103. In addition to the well-known required multi-step analysis of Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966), and its progeny, the Court of Appeals for the Federal Circuit has on numerous occasions offered its guidance concerning the propriety of Section 103 rejections.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so¹. (emphasis original)

The task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, ' 103.² (footnotes omitted)

1 ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

2 Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987).

In In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986), the court reversed a Patent Office Board of Appeals decision rejecting claims for obviousness, saying: "There [was] nothing in the prior art references, singly or in combination, 'to suggest the desirability, and thus the obviousness' of the [claimed subject matter]." Id. at 315; emphasis original. The court noted that the relied-on reference did not address the technical problem addressed by the claimed invention (and in fact taught away from the Applicant's invention), and stated the well-established principle that "[h]indsight analysis is clearly improper. . . ." Id. at 316.

In Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416 (Fed. Cir. 1986), the court vacated a district court holding of invalidity for obviousness. In doing so, the district court was criticized for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations. Id. at 419, 420.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art³. (emphasis added)

The Supreme Court in Graham and Adams . . . foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. [footnote omitted] Where the legal conclusion is not supported by facts, it cannot stand. . . .

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. . . .

3 Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986).

[W]e may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness⁴. (emphasis original)

Finally, the PTO Board of Appeals noted the following in Ex parte Clapp:

"[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness.⁵"

The following analysis of the present rejection is respectfully offered with guidance from the foregoing controlling case law decisions.

With reference now in particular to the outstanding rejection of original claims 1-3, 5-8, 10-13, 15-18, and 20-29 under 35 U.S.C §103(a) as being allegedly unpatentable over U. S. Patent No. 6,269,373 to Apte et al. (Apte) in view of U. S. Patent No. 6,237,135 to Timbol and further in view of U. S. Patent No. 6,836,889 to Chan et al. (Chan), it should first be noticed that each of independent claims 1, 6, 11, and 16 are variously directed to either of a system, method, or computer readable medium that recites, *inter alia*, automatic bean generation.

More specifically, independent claim 1 (emphasis added) recites "A system for providing interaction between a client and a server, comprising: **means for automatically generating a bean**; means for providing at least one property that the bean represents; means for providing a property field that describes usage of an attribute for the bean; means for providing a type that describes the bean; and means for utilizing the bean as a cache entity."

Independent Claim 6 (emphasis added) more specifically recites **automatic** bean generation by including the steps by which the bean is generated by calling for "A method for providing interaction between a client and a server, the method comprising the steps of: **automatically generating a bean**, comprising the steps of: providing at

⁴ In re Warner, 379 F.2d 1011, ___, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967).

⁵ Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

least one property that a bean represents; providing a property field that describes the usage of an attribute for the bean; and providing a type that describes the bean; and using the bean to provide interaction between a client and a server."

Without recitation of the body of independent claim 11 within these remarks, it should be noted that claim 11 is generally directed to the same subject matter as claim 6 but couched in terms of a computer readable medium while still calling for **automatic** bean generation including logic to otherwise provide various features as recited in claim 6.

Independent Claim 16 (emphasis added) is directed to a system including **automatic** bean generation as it calls for: "A system for providing interaction between a client and a server, comprising: **an automatically generated bean**, wherein said bean further comprises: at least one property that identifies the bean; a property field that describes usage of an attribute for the bean; a type that describes the bean; and a cache for storing transient values for the at least one property for subsequent retrieval after a first use." Thus, claim 16 also includes specific limitations of the bean.

The Apte Patent cited by the Examiner in support of the outstanding rejection is directed to a method and system for persisting beans as container-managed fields. Appropriately, while the recent Office Action states that Apte discloses some of the features of the present subject matter, the recent Office Action expressly recognizes and concedes (numbered page 4) that Apte does not "... teach explicitly means for automatically generating a bean."

In an effort to supply this clearly missing teaching, the recent feedback cites U. S. Patent No. 6,237,135 to Timbol as allegedly supplying such disclosure which, according to the recent Office Action would have rendered it "... obvious to one of ordinary skill in the art at the time the invention was made to modify Apte in view of Timbol to provide means for automatically generating a bean. One would be motivated to do so to allow a user to create Java Beans-compatible components rapidly and easily."

Respectfully, it is not applicants' intention, **nor is it applicants' claim** that there be a system or method that allows a "user to create" beans. Rather, **it is applicants' disclosure and claim that beans are automatically created.**

Timbol has described a "wizard" that assists a user in creating programming. He does not describe **automatic** bean generation, as applicants have described in their specification and as affirmatively claimed with the present active claims. With reference to Timbol, at column 4 starting with line 15, it is stated (emphasis added):

In typical operation of the system, the user may generate a bean by invoking a wizard-based interface that implements methodology for automatically generating and managing a Java Bean or simply "bean." First, the user invokes a Java Bean (JavaBean) **Wizard** (dialog). **The user employs the Java Bean Wizard** to specify the name of the bean, the package it will be in, and the class it extends from. Here, **the user specifies** the package he or she wants the bean to be part of. By default, this will be the name of the user's current project. Next, **the user gives** the bean being created a name; **the user** can choose a class to extend, from a drop-down list. The drop-down list presents a list of convenient classes to use for constructing a new Java Bean. **The user** can use one of these classes, or can click the adjacent button to display a Package browser provided by the system for specifying any existing Java class desired. **The user chooses** any remaining options desired, such as checking "Allow Only Java Beans" if the user wants the system to warn when the user tries to extend a Java class that is not a valid Java Bean. Finally, **the user selects an OK button to indicate completion of input for the wizard.** In response to the foregoing input, the system creates a Java Bean with the name the user specified, places it in the user's current project, and displays the source code generated for the bean.

Respectfully, in accordance with the above-noted case law, there would be no reason for a person of ordinary skill in the art to modify Apte to include a "wizard" to help a user create jellybeans. Moreover, considering hypothetically, even if such a wizard were incorporated into Apte, such would not provide the **automatically generated** beans as recited in the presently claimed subject matter but rather would actually **teach away** from the presently claimed subject matter by implementing a system whereby when a bean was required for communication between a client and a server, a user would

actually have to enter data via the wizard before the communications could proceed. Such required manual entry would certainly not be beneficial to the efficient operation of a server/client communications system.

Chan, additionally cited in the recent Office Action as providing motivation for using a bean as a cache, also does **not** disclose automatic bean generation, and thus also fails to cure the deficiencies of Apte even as potentially modified by Timbol.

Simply put, no suggestion has been found in either Timbol or Chan that discloses or makes obvious a method, system or computer readable medium incorporating automatic bean generation as disclosed **and claimed** by applicants.

In light of the above Remarks, Applicants respectfully submit that no combination or modification of Apte in view of Timbol and/or further in view of Chan makes obvious present claims 1-3, 5-8, 10-13, 15-18, and 20-29, and acknowledgement of the same is respectfully requested. As such, withdrawal of the obviousness rejection of such claims is respectfully requested.

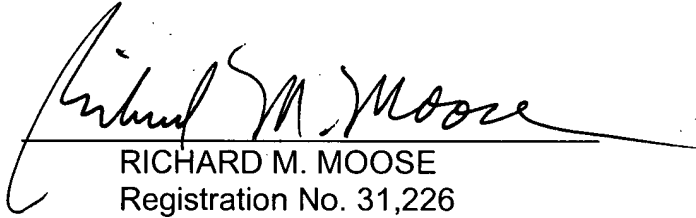
CONCLUSION:

Inasmuch as all outstanding issues have been addressed, it is respectfully submitted that the present application, including claims 1-3, 5-8, 10-13, 15-18, and 20-29, is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this response in order to permit early resolution of the same or if he has any questions regarding this matter.

Respectfully submitted,

DORITY & MANNING,
ATTORNEYS AT LAW, P.A.

April 20, 2006
Date



RICHARD M. MOOSE
Registration No. 31,226

P. O. Box 1449
Greenville, South Carolina 29602-1449
Telephone: (864) 271-1592
Facsimile: (864) 233-7342